

REMARKS

Applicants have carefully reviewed the arguments presented in the Office Action and respectfully request reconsideration of the claims in view of the remarks presented below.

In the aforesaid Office Action, claims 1-21 were rejected under 35 USC § 102(e) as anticipated by Lim et al. (U.S. Patent No. 6,344,045), and as anticipated by Lee et al. (U.S. Patent No. 6,287,314). Claims 1-10, and 13-19 are pending (claims 11, 12, 20 and 21 being cancelled by this amendment).

The Examiner rejected claims 1-21 under 35 USC § 102(e) as anticipated by Lim et al. or Lee et al., stating that the references disclose a catheter having a wingless balloon which causes or which is capable of damage or rupture to the vulnerable plaque when inflating. The Examiner states in the Response to Arguments section that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and prior art to patentably distinguish the prior art, and that if a prior art structure is capable of performing the intended use then it meets the claim.

However, Applicants currently pending claims are directed to a method of performing a medical procedure, and are not apparatus claims directed to a structure. As such, a structural difference between the claimed invention and the prior art is not required to patentably distinguish the prior art, and a prior art structure does not meet the claim merely by being capable of performing an intended use where the claims set forth method steps which are not disclosed or suggested by the prior art.

Specifically, claims 1 and 13 require performing an analytical method on a plaque intended to identify the plaque as vulnerable plaque (support for the amendment can be found in the fourth paragraph of the Detailed Description section of Applicants' specification). Lee et al. and Lim et al. do not disclose or suggest the step of first performing an analytical method on the plaque to identify the plaque as vulnerable plaque. Therefore, irrespective of whether the wingless balloons of Lee et al. and Lim et al. are capable of performing an intended use, because the references do not disclose each

and every element of the claims, the Examiner has not met the requirement of a rejection under 35 USC § 102(e).

Moreover, claim 1 requires inflating the balloon to damage plaque by disrupting the fibrous cap of the plaque without cap rupture, to thereby strengthen the vulnerable plaque by inducing extracellular matrix protein synthesis. In contrast, Lee et al. and Lim et al. do not disclose or suggest a method in which the balloon is inflated such that a vulnerable plaque is damaged, while limiting the effect of the balloon on the vulnerable plaque so that the fibrous cap of the vulnerable plaque does not rupture. Therefore, the Examiner has not established a prima facie case under 35 USC § 102(e) because irrespective of whether the wingless balloons of Lee et al. and Lim et al. are capable of performing the method step recited in Applicant's claim, the references do not disclose or suggest performing a method in which the plaque is damaged by disrupting the fibrous cap of the plaque without cap rupture, to thereby strengthen the vulnerable plaque by inducing extracellular matrix protein synthesis.

Additionally, claims 13-15 are directed to a method requiring the steps of determining a diameter of a portion of a body lumen having the vulnerable plaque, and inflating the wingless balloon using a diameter-limiting inflation device to inflate the balloon to an expanded diameter selected to correspond to the diameter of the portion of the body lumen having the plaque, which are not disclosed or suggested by the references. Thus, Applicants respectfully request that the rejection under 35 USC 102(e) be withdrawn because Lim et al. and Lee et al. do not disclose every aspect required by claim 13.

Applicants wish to bring to the attention of the Patent Office the reference(s) listed on the attached PTO/SB/08a, and request that they be considered by the Examiner.

Copies of U.S. patent references are omitted pursuant to 1287 Off. Gaz. Pat. Off. 163, 10/19/2004: "Section 1.98(a)(2)(i) is amended to eliminate the requirement in paragraph (a)(2)(i) for a copy of each U.S. patent or U.S. patent application publication listed in an IDS in a patent application regardless of the filing date of the application."

This statement is not a representation that all of the information cited is necessarily effective as prior art against the present application or that a prior art search was performed.

This Information Disclosure Statement is being submitted pursuant to 37 CFR 1.97(b)(4), before the mailing of a first Office Action after the filing of a request for continued examination, and therefore no fee is due. However, if a fee is in fact due, the Commissioner is authorized to charge any additional fee(s) to our Deposit Account No. 06-2425. A duplicate copy of this paper is enclosed.

In view of the foregoing, it is respectively urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at (310) 824-5555 to facilitate prosecution of this application, if necessary.

Applicant respectfully requests reconsideration, and issuance of a timely Notice of Allowance.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP

By: _____



Gunther O. Hanke

Registration No. 32,989

GOH:kh

Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201